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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,882	05/27/2005	Klaus Hug	2002P16792WOUS	6607

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SIEMENS SCHWEIZ AG
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ZURICH, CH-8047
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EXAMINER

KIM, AHSHIK

ART UNIT	PAPER NUMBER
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2876

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/536,882

Applicant(s)

HUG ET AL.

Examiner

Ahshik Kim

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/7/05 (Preliminary Amendment).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6 and 7 is/are rejected.
- 7) ☒ Claim(s) 8 and 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 5/27/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers
5 have been placed of record in the file.

Preliminary Amendment

2. Receipt is acknowledged of the preliminary amendment filed on May 27, 2005.
Currently, claims 6-9 remain in the examination.

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Obviousness-Type Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple
15 assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

20 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 6 and 7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of US Patent 7,108,524 to Wahler (hereinafter "Wahler").

Although the conflicting claims are not identical, it is the Examiner's view that they are not patentably distinct from each other. In claim 1 of the of the instant application, the Applicant claims "A smart card holder comprising:

- a first central part and a drive means arranged to move the first central part, and
- 5 - a second central part comprising drive elements arranged to form a stop for a smart card and for driving the smart card during an ejection movement, in order to move said card out of the smart card holder, starting from a first operating position in which the smart card is fully held,
- a blocking element arranged to prevent the second central part from moving in the first operating position and which can be operated by the first central part in such a way that locking
- 10 is canceled in a second operating position when the smart card is fully held, and
- the first and second central parts are arranged to drive one another in the second operating position by means of a coupling element, wherein the second central part is driven by the first central part for the ejection movement."

Wahler discloses in claim 1 a smart card holder comprising an ejector, at least one

15 locking arm and a lug which is a pin attached to the ejector, among other things. In claim 2, Walther further discloses "the track guide comprises two sections arranged at an angle to one another, the first section running essentially transverse to the ejection direction and the lug extending through the first section when the smart card is inserted, and the second section running in the ejection direction and the lug extending through the second section when the

20 smart card is ejected."

It is the Examiner's position that Wahler's first section equates to a first central part, and a second section a second central part of claim 1 of the instant application. The first section and

Art Unit: 2876

second section are arranged to drive one another in opposite direction with the lug being the coupling element of the first section and second section.

Thus, with respect to above discussions, it would have been obvious to an artisan at the time the invention was made to use the teaching of claims 1 and 2 of Wahler as a general teaching to design a similar (if not identical) smart card holder claimed in the instant application. To the extent that the instant claim is broader (or substantially identical) and therefore generic to the patented claims [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been patented.

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Allowable Subject Matter

Claims 8 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The claims are directed at a smart card holder comprising a first central part, a second central part, a blocking element, and a coupling element which couples the first central part and

Art Unit: 2876

second central part. The first central part comprises a section having an arrow-like contour and arranged to operate the blocking element. Or the blocking element is formed by two sprung cross-sliders situated opposite one another on the side of the arrow-like section. Such smart card holder is neither disclosed nor suggested by the cited references.

Conclusion

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Reichardt et al. (US 6,234,391); Sugimoto (US 5,729,000); Yamaguchi (US 6,869,017); Reichardt et al. (US 6,736,318); Takahashi et al. (US 6,951,473); Odic (US 6,073,853); Larabell (US 5,518,412) disclose smart card readers/holders. Applicant is respectfully suggested to carefully review these references.

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax phone number for this Group is (571)273-8300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available for Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions or access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/536,882
Art Unit: 2876

Page 6



Ahshik Kim
Primary Examiner
Art Unit 2876
February 9, 2007